

Attorney Docket No.: DEX-0117
Inventors: Salceda et al.
Serial No.: 09/721,183
Filing Date: November 22, 2000
Page 15

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REMARKS

Claims 7, 18-20, 22-24, 26-28, 30-32, 34-36 and 38-82 are pending in the instant application. Claims 7, 18-20, 22-24, 26-28, 30-32, 34-36 and 38-82 have been rejected. Claims 3, 4, 5, 6, 7, 19, 20, 23, 24, 27, 28, 31, 32, 35, 36, 38, 39, 40, 41, 42, 45, 49, 53, 57, 61, 65, 69, 73, 77 and 81 have been amended. Claims 18, 22, 26, 30, 34, 46, 50, 54, 58, 62, 66, 70, 74, 78 and 82 have been canceled. No new matter is added by these amendments. Reconsideration is respectfully requested in light of these amendments and the following remarks.

I. Rejection of Claims 3, 7, 18-20, 22-24, 26-28, 30-32, 34-36, 38-46, 49, 50, 53, 54, 57, 58, 61, 62, 65, 66, 69, 70, 73, 74, 77, 78, 81 and 82 under 35 U.S.C. 112, first paragraph

Claims 3, 7, 18-20, 22-24, 26-28, 30-32, 34-36, 38-46, 49, 50, 53, 54, 57, 58, 61, 62, 65, 66, 69, 70, 73, 74, 77, 78, 81 and 82 have been rejected under 35 U.S.C. 112, first paragraph. The Examiner has acknowledged the specification to be enabling for determining the polynucleotide of SEQ ID NO:1 or 2 in breast tissue or whole blood. However, the Examiner suggests that the specification does not reasonably provide enablement for a method of determining the polynucleotide of SEQ ID NO:1 or 2 in blood derivatives, urine, saliva or other bodily secretions.

Attorney Docket No.: DEX-0117
Inventors: Salceda et al.
Serial No.: 09/721,183
Filing Date: November 22, 2000
Page 16

Accordingly, in an earnest effort to advance the prosecution but without conceding to the Examiner's position, Applicants have amended the claims to state cells, tissues and whole blood.

Withdrawal of this rejection under 35 U.S.C. 112, first paragraph is therefore respectfully requested.

II. Rejection of Claims 3-7, 18-20, 22-24, 26-28, 30-32, 34-36 and 38-82 under 35 U.S.C. 112, second paragraph

Claims 3-7, 18-20, 22-24, 26-28, 30-32, 34-36 and 38-82 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner maintains that recitation of "stringent" conditions does not define the metes and bounds of the physical parameters of the hybridization conditions.

Accordingly, in an earnest effort to advance the prosecution but without conceding to the Examiner's position, Applicants have amended the claims to delete this phrase.

Withdrawal of this rejection under 35 U.S.C. 112, second paragraph is therefore respectfully requested.

Attorney Docket No.: DEX-0117
Inventors: Salceda et al.
Serial No.: 09/721,183
Filing Date: November 22, 2000
Page 17

**III. Rejection of Claims 3-7, 18-20, 22-24, 26-28, 30-32, 34-36 and 38-82 under 35 U.S.C. 112, first paragraph -
Written Description**

Claims 3-7, 18-20, 22-24, 26-28, 30-32, 34-36 and 38-82 have been rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement. In particular, the Examiner suggests that Applicants were not in possession of the genus of polynucleotides that hybridize to the anti-sense of SEQ ID NO:1, 2, 4, 5 or 18.

Accordingly, in an earnest effort to advance the prosecution but without conceding to the Examiner's position, Applicants have amended the claims to delete this phrase.

Withdrawal of this rejection under 35 U.S.C. 112, first paragraph is therefore respectfully requested

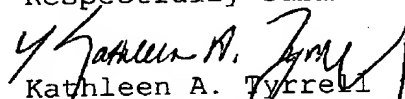
IV. Conclusion

Applicants believe that this submission overcomes all pending rejections in this case and comprises a full and complete response to the Office Action of record.

Attorney Docket No.: DEX-0117
Inventors: Salceda et al.
Serial No.: 09/721,183
Filing Date: November 22, 2000
Page 18

Accordingly, favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.

Respectfully submitted,


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